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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,355	07/06/2000	Cary Gresham Bayne	CDOC-002	6374

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EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/611,355

Applicant(s)

BAYNE, CARY GRESHAM

Examiner

Natalie A. Pass

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llb

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 and 62-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-61 and 69-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 5 March 2004. Claims 1-30 and 62-68 have been withdrawn as being drawn to a nonelected invention. Claims 31 and 47 have been amended. Claims 69-71 have been newly added. Claims 1-71 remain pending.

Specification

2. The objection to the abstract of the disclosure because of undue length is hereby withdrawn due to the amendment filed 5 March 2004.

Election/Restrictions

3. This application contains claims 1-30 and 62-68 drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Newly amended claim 69 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Newly added claim 69 recites the limitations "said response personnel description" on line 15.

There is insufficient antecedent basis for this limitation in the claim. For the purpose of finding art, Examiner assumes the limitation to read "a personnel description."

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 31-61, 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff, U.S. Patent Number 6, 022, 315 in view of Reuss et al., U.S. Patent Number 6, 364, 834, for substantially the same reasons given in the previous Office Action (paper number 12), and further in view of Vogue Healthbeat, Vital Signs, They Deliver article, September 1998. URL: <<http://www.ampmdoc.com/media/press/vogue.htm>> hereinafter known as Vogue. Further reasons appear hereinbelow.

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- (A) Claims 31 and 47 have been amended to include the recitation of
- "to request screening information from the patient to determine the severity of the medical condition of the patient," in lines 3-5 and 5-7 respectively;
 - "determining whether or not the patient is appropriate to receive a non-emergency house call, in response to screening information received from the patient," in lines 7-9 and 10-12 respectively;
 - "sending a message to the patient recommending he or she not receive a non-emergency house call at this time when a non-emergency house call is determined to be not appropriate," in lines 10-12 and 14-16 respectively; and
 - "to make a non-emergency house call when it is determined to be appropriate," in lines 14-15 and 18-19 respectively.

As per these new limitations, Iliff and Reuss teach a method of providing medical care as analyzed and discussed in the previous Office Action (paper number 12) further comprising to request screening information from the patient to determine the severity of the medical condition of the patient (Iliff; column 25, line 48 to column 26, line 45, column 61, lines 3-34).

Although Iliff and Reuss teach determining whether or not the patient requires emergency treatment, in response to screening information received from the patient (Iliff; column 25, line 48 to column 26, line 45, column 61, lines 3-34), Iliff and Reuss fail to explicitly disclose

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determining whether or not the patient is appropriate to receive a non-emergency house call, in response to screening information received from the patient;

selecting appropriate personnel to make a non-emergency house call when it is determined to be appropriate; and

sending a message or communicating to the patient recommending he or she not receive a non-emergency house call at this time when a non-emergency house call is determined to be not appropriate.

However, the above features are well-known in the art, as evidenced by Vogue.

In particular, Vogue teaches

determining whether or not the patient is appropriate to receive a non-emergency house call, in response to screening information received from the patient (Vogue; column 3, lines 2-14);

send a physician within an hour (reads on selecting appropriate personnel to make a non-emergency house call when it is determined to be appropriate) (Vogue; column 3, lines 2-14); and

urging those with emergencies to call 911 (reads on sending a message or communicating to the patient recommending he or she not receive a non-emergency house call at this time when a non-emergency house call is determined to be not appropriate) (Vogue; column 3, lines 2-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of providing medical care of Iliff and Reuss to include determining whether or not the patient is appropriate to receive a non-emergency house call, in response to screening information received from the patient; selecting appropriate personnel to

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make a non-emergency house call when it is determined to be appropriate; and sending a message or communicating to the patient recommending he or she not receive a non-emergency house call at this time when a non-emergency house call is determined to be not appropriate, as taught by Vogue, with the motivations of quickly and economically delivering medical services to where they are needed (Vogue; column 3, lines 2-14).

The motivations for combining the respective teachings of Iliff and Reuss are as given in the rejection of claim 31 in the prior Office Action (paper number 12) and incorporated herein.

The remainder of claims 31 and 47 is rejected for the same reasons given in the prior Office Action (paper number 12, section 7, pages 3-11), and incorporated herein.

(B) As per newly added claim 69, Iliff, Reuss and Vogue teach a method of providing medical care comprising:

receiving patient medical information (Iliff; see at least Figures 24, 25b, 26-30, Abstract, column 14, lines 49-56, column 26, lines 28-45, column 28, line 55 to column 29, line 11, column 41, line 54 to column 42, line 25, column 67, line 20 to column 68, line 44, column 69, line 16 to column 71, line 51, column 72, line 54 to column 73, line 30, column 76, line 44 to column 77, line 19);

executing a computer program to review said medical information and to request screening information from the patient to determine the severity of the medical condition of the patient (Iliff; see at least Figures 24, 25b, 26-30, Abstract, column 14, lines 49-56, column 25, line 48 to column 26, line 45, column 28, line 55 to column 29, line 11, column 41, line 54 to column 42, line 25, column 61, lines 3-34, column 67, line 20 to column 68, line 44, column 69,

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line 16 to column 71, line 51, column 72, line 54 to column 73, line 30, column 76, line 44 to column 77, line 19);

requesting screening information from the patient to determine the severity of the medical condition of the patient (Iliff; column 25, line 48 to column 26, line 45, column 61, lines 3-34);

determining whether or not the patient is appropriate to receive a non-emergency house call, in response to screening information received from the patient (Iliff; column 25, line 48 to column 26, line 45, column 61, lines 3-34), (Vogue; column 3, lines 2-14);

sending a message or communicating to the patient recommending he or she not receive a non-emergency house call at this time when a non-emergency house call is determined to be not appropriate or urging those with emergencies to call 911 (Vogue; column 3, lines 2-14);

accessing a computer data base to select appropriate personnel (Iliff; see at least Figures 24, 25b, 26-30, Abstract, column 14, lines 49-56, column 26, lines 28-45, column 28, line 55 to column 29, line 11, column 41, line 54 to column 42, line 25, column 67, line 20 to column 68, line 44, column 69, line 16 to column 71, line 51, column 72, line 54 to column 73, line 30, column 76, line 44 to column 77, line 19) according to said response personnel description to make a non-emergency house call when it is determined to be appropriate or sending a physician within an hour (Vogue; column 3, lines 2-14); and,

sending wireless dispatch information or notification to said appropriate personnel or sending a physician to make a non-emergency house call to the patient when such a house call is determined to be appropriate (Reuss; column 3, lines 35-59, column 5, lines 37-63), (Vogue; column 3, lines 2-14).

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The motivations for combining the respective teachings of Iliff, Reuss and Vogue are as given in the rejection of claim 31 in the prior Office Action (paper number 12) and above, incorporated herein.

(C) As per newly added claims 70-71, Iliff, Reuss and Vogue teach a method as analyzed and discussed in claim 69 above, further including

sending or receiving messages electronically during a house call concerning the patient's medical condition (Reuss; column 4, line 55 to column 5, line 63, column 16, lines 34-45);

storing at least some of the messages locally (Iliff; column 2, lines 1-65, column 23, lines 49-57, column 24, lines 14-41, column 28, lines 23-55), (Reuss; column 15, lines 3-10).

(D) Claims 32-46 and 48-61 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 12, section 7, pages 3-11), and incorporated herein.

Response to Arguments

8. Applicant's arguments filed 5 March 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 5 March 2004.

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(A) At pages 18-20 of the 5 March 2004 response, Applicant argues that the limitations claimed in originally filed Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 5 March 2004 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Iliff, Reuss and Vogue based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 12), and incorporated herein. In particular, Examiner notes that accessing a computer database to select appropriate personnel according to a response description to make a non-emergency house call and executing a computer program to request screening information from the patient are taught by the cited references (Iliff; see at least Figures 24, 25b, 26-30, Abstract, column 14, lines 49-56, column 25, line 48 to column 26, line 45, column 28, line 55 to column 29, line 11, column 41, line 54 to column 42, line 25, column 61, lines 3-34, column 67, line 20 to column 68, line 44, column 69, line 16 to column 71, line 51, column 72, line 54 to column 73, line 30, column 76, line 44 to column 77, line 19), (Vogue; column 3, lines 2-14).

(B) At pages 19-20 of the 5 March 2004 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

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USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument on page 20 that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Iliff's system and method of providing computerized knowledge-based medical diagnostic and treatment advice (Iliff; Abstract) to include Reuss's invention, which "determine[s] the location of a plurality of caregivers and select an appropriate primary ...[caregiver]... based on location" and which sends wireless dispatch information to appropriate personnel (Reuss; column 3, lines 35-59, column 5, lines 37-64) with the motivation of providing a medical monitoring system which enables transmission of messages, including medical alert, from the central monitoring system to wireless, remote access devices, which may themselves reply or communicate with each other, and in which secure delivery of a medical alert message can be guaranteed by utilizing an integral wireless communications system and which enables

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automatic transfer of patient data from the central monitoring system to auxiliary systems for analysis, display, storage and/or retrieval (Reuss; column 3, lines 35-59).

Moreover, the Examiner respectfully submits that Applicant is not the first to invent a method of directing physician house calls. The use of screening information as a prerequisite to delivery of physician house calls, as described above was well established in the prior art, as, for example, shown by Suzuki (5, 986, 568) and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257,

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1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti* et al 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art of record and the article disclose an information transfer method and system, and system for supporting various operations including visiting clinicians systems (US 5, 986, 568), a method and system aiding medical diagnosis and treatment (5, 974, 124) and a call doctor system. These references are provided herein at this stage of prosecution in response to the new claims and limitations added in the 5 March 2004 amendment.

Cox, J.W. House call doctor expanding his operation. February 13, 1998. South Florida Business Journal. [Retrieved from the Internet on April 29, 2004]. URL: <<http://www.bizjournals.com/southflorida/stories/1998/02/16/story3.html>>.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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11. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
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or faxed to:

(703) 305-7687.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

April 29, 2004

*Alexander Alexander
RECEIVED Kucowski
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Pammy (Kucowski)*